

**REMARKS**

Claims 17-23, 25 and 46-59 are pending in the present application.

Claims 17-23, 25 and 58-59 have been withdrawn, but not canceled.

Claim 17 was amended herein solely for clarity.

Reconsideration of the claims is respectfully requested.

**35 U.S.C. § 101 (Restriction)**

The Office Action asserts that the product as claimed can be made by another and materially different process since:

[C]hemical vapor deposition (CVD) and thermal oxidation are two distinctively well known techniques of forming an oxide layer which can alternatively be used to form the oxide layer over the gate structure of the instant invention.

Paper No. 12, page 5. However, the standard for restriction is not merely whether different (but interchangeable) processes for forming an oxide layer, but whether the processes are patentably distinct. The record contains no evidence that chemical vapor deposition and thermal oxidation produce physically or chemically different oxides, or that the processes may not be readily substituted for each other.

**35 U.S.C. § 102 (Anticipation)**

Claims <sup>46</sup>~~48~~ and 48 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,422,291 to *Clementi et al.* This rejection is respectfully traversed.

Independent claim 46 recites a nitride layer on the gate oxide layer. Such a feature is not depicted or described in the cited reference. *Clementi et al* depicts in Figure 12 and describes in the associated text a gate structure including a gate oxide 4, a polysilicon floating gate 5 on the gate oxide 4, and a composite O-N-RTN layer 6 including nitridized polysilicon 6a, silicon nitride 6b, and oxidized silicon nitride 6c on the polysilicon floating gate 5. Thus, *Clementi et al* is silent as to a nitride layer on a gate oxide, depicting and describing instead a nitride layer over the gate oxide.

The Examiner cites (apparently one of several definitions within) Merriam-Webster's Collegiate Dictionary (which was not attached to the final Office Action as stated) as support for an interpretation of "on" as merely requiring a "position in close proximity." In addition to the prosecution history estoppel created by prior arguments, Applicant has amended independent claim 46 to explicitly recite direct contact between the nitride and oxide layers.

Therefore, the rejection of claims 46 and 48 under 35 U.S.C. § 102 has been overcome.

**35 U.S.C. § 103 (Obviousness)**

Claims 47 and 56–57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Clementi et al*. This rejection is respectfully traversed.

As noted above, independent claim 46 recites at least one feature not depicted or described in *Clementi et al*. Moreover, no motivation or incentive for modifying the teachings of *Clementi et al* to achieve the claimed invention has been identified, nor any basis for deriving a reasonable expectation of success in making such modification.

In addition, the statement concerning the dimensional parameters recited in claims 47 and 56–57 within the Office Action is not an accurate statement of the current law. Obviousness inquiries, due to their highly fact-specific and fact-intensive nature, have been deemed not to be amenable to *per se* rules such as that expressed in the Office Action. *In re Ochiai*, 71 F.3d 1565, 1569 (Fed. Cir. 1995). Mere citation of a *per se* rule regarding what constitutes obvious modifications, without identifying a motivation or incentive for the proposed modification, does not establish a *prima facie* case of obviousness.

The final Office Action acknowledges this standard, but fails to address this shortcoming in the rejection.

Therefore, the rejection of claims 47 and 56–57 under 35 U.S.C. § 103 has been overcome.

**35 U.S.C. § 101 (Double Patenting)**

Claims 46–55 were rejected under the judicially created doctrine of obviousness-type (nonstatutory) double patenting grounded in 35 U.S.C. § 101.

Applicant respectfully requests that the requirement of a terminal disclaimer be deferred until subject matter is held allowable in this application.

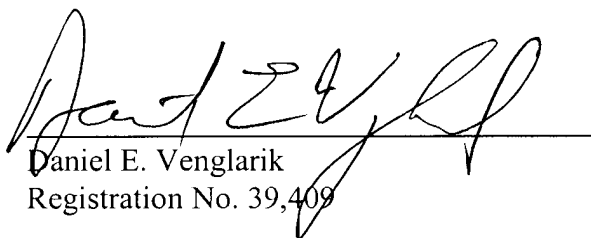
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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